

The opinion in support of the decision being entered today was
not written for
publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PAUL R. GAGNON

Appeal No. 2006-1562
Application No. 10/720,948

ON BRIEF

MAILED
AUG 24 2006

U.S PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Before GARRIS, WALTZ and TIMM, Administrative Patent Judges.

GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal, which involves claims
1-18.

We REVERSE and REMAND.

The subject matter of this appeal is directed generally to a sports vision-training device, and a method for its use, for directing an individual's field of vision up and toward the field of play. The training device also restricts, in some cases completely, the individual's field of vision with regard

to the sports object (i.e. ball, puck, etc.) being controlled.
(Specification, page 1, ¶ [0001]).

Further details regarding this subject matter are set forth in representative independent claims 1, 10 and 18 which read as follows:

1. A sports vision training device comprising:

a piece of material having a thickness sufficient to interfere with an individual's ability to look in a specific direction at a sporting object being controlled by the individual; and

said piece of material having an adhesive coating or layer for positioning said piece of material on a portion of an individual's face so that said piece of material interferes with said individual's ability to look at said sporting object while attempting to control said sporting object due to said thickness.

10. A system for training an individual encouraging them to look up and forward while playing a sport without looking down at an object being controlled by said individual, said system comprising:

a pair of potentially disposable view restricting members;

each said member being adhesively applied to one of the cheeks under an eye of said individual;

and each said member having a thickness sufficient to interfere with said individual's vision if said individual attempts to look down and sufficient to encourage said individual to look in an up and forward direction towards a field of play and at least one player on said field of play.

18. A method for training an individual playing a sport,
said method comprising the steps of:

providing at least one member having an adhesive
coating or layer and a thickness sufficient to interfere
with said individual's field of vision; and

positioning said at least one member on at least one
cheek under an eye of said individual so that said
thickness interferes with the individual's ability to look
downwardly at a sports object being controlled by the
individual and to restrict said individual's field of
vision to looking forward up and towards a field of play
and at least one person on said field of play.

The references set forth below are relied upon by the

Examiner as evidence of anticipation or obviousness:¹

| | | |
|--------------------------|-------------|---------------|
| Maged | WO 96/32979 | Oct. 24, 1996 |
| Micchia et al. (Micchia) | 4,719,909 | Jan. 19, 1988 |
| Morgan et al. (Morgan) | 4,951,658 | Aug. 28, 1990 |

The following reference is cited by the Board and is
discussed in the remand below for consideration by the Examiner:

Arnold et al. (Arnold) 6,320,094 Nov. 20, 2001

Claims 1-2 are rejected under 35 U.S.C. § 102(b) as being
unpatentable over Maged.

¹The Examiner has referred to U.S. Patent 5,939,142 to Comiskey et al. in the Response to Arguments section of her answer. We have not considered this reference because it was not included in a statement of rejection. See In re Hoch, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n.3 (C.C.P.A. 1970) and Manual of Patent Examining Procedure (MPEP) § 1207.03 (Rev. 3, August 2005).

Claims 1-4, 6, 9-12, 14-16, 18 are rejected under 35 U.S.C. § 102(b) as being unpatentable over Micchia.²

Claims 7-8 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Micchia.

Claims 5, 13 and 17 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Micchia in view of Morgan.

Rather than reiterate the respective positions advocated by the Appellant and by the Examiner concerning these rejections, we refer to the brief and reply brief and to the answer respectively for a complete exposition thereof.

OPINION

For the reasons provided below, none of rejections can be sustained.

Under the circumstances presented by this appeal, the propriety of the all the rejections will be determined by our assessment of the § 102 rejections of the independent claims 1, 10 and 18 over Micchia and independent claim 1 over Maged. Thus, we focus on these rejections. With respect to the Micchia and Maged patents, Appellant primarily argues that neither patent

² The 35 U.S.C. § 102 rejection of claim 14 is improper. Claim 14 is dependent upon claim 13. Claim 13 is rejected under 35 U.S.C. § 103(a). As such, the § 102 rejection over claim 14 is not appropriate because it conflicts with the obviousness-based rejection of the parent claim.

teaches a sports vision-training device with a "thickness sufficient" to perform the various vision-interference functions in independent claims 1, 10 and 18. (Brief, pages 7-9, 12 and 14). The Examiner bases her rejections on inherency by stating the following: "It should be noted the thickness of the piece of material inherently interferes with said individual's ability to look at any object including a sports objection [sic, object]." (Final Office Action, pages 3-4, ¶¶ 3 and 4). In supporting her inherency finding, the Examiner states that, since Appellant has not claimed any specific thickness (i.e. no numerical value for the thickness has been claimed), then both Maged and Micchia may be considered to have "sufficient" thickness to interfere with an individual's vision. (Answer, page 7). As further rationale for her inherency determination, the Examiner states that "any material positioned under the eyes will cause some degree of interference with the field of vision. . . ." (Answer, page 7).

A rejection based upon the doctrine of inherency requires an examiner to provide a basis-in-fact and/or technical reasoning to reasonably support a determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. Ex Parte Levy, 17 USPQ2d 1461, 1463-1464 (Bd. Pat. App. & Int. 1990). Moreover,

inherency may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (C.C.P.A. 1981).

We find that the Examiner has not met her initial burden of establishing that Maged or Micchia inherently discloses the claimed sufficient "thickness" limitation. We agree with the Appellant's argument made in his reply brief: the Examiner has merely provided a conclusory statement that Maged's and Micchia's thickness must inherently be sufficient to interfere with the individual's ability to look at any object. (Reply Brief, page 2, in comparison with Final Office Action, pages 3 and 4). The Examiner has failed to provide any citation from the text of the Maged or Micchia patent, or any technical reasoning to show that either patent inherently meets the Appellant's sufficient "thickness" limitation. Notably, both Maged and Micchia are silent regarding the exact thickness of their respective inventions. Maged says nothing about his article thickness, whereas Micchia only vaguely states that the device is "thin and pliable". (Micchia, column 3, line 43). In view of Maged's and Micchia's silence regarding thickness and the Examiner's failure to provide any basis-in-fact or technical

reasoning in support of her inherency position, we determine that the Examiner has failed to meet her burden of showing that the here claimed "thickness" feature necessarily and inherently flows from the teachings in the Maged or Micchia patents. Rather, the Examiner is improperly dealing in "probabilities" and "possibilities" regarding the claimed thickness.

The Examiner is correct that both the Maged and Micchia patents show in their drawings that the article and device thereof have a thickness. (Answer, page 7). However, because the drawings are not indicated as being drawn to scale, we cannot conclude from the drawings what the respective thicknesses actually are. Drawings may only be used to show actual dimensions when the patent indicates that the drawings contained therein are drawn to scale. Hockerson-Halberstadt, Inc. v. Avia Group International, Inc., 222 F.3d 951, 956, 55 USPQ2d 1487, 1491 (Fed. Cir. 2000), Manual of Patent Examining Procedure (MPEP) § 2125 (Rev. 3, August 2005). At best, the patents are ambiguous as to whether Appellant's sufficient "thickness" limitation is taught. An anticipation rejection cannot be predicated on an ambiguous reference. In re Turlay, 304 F.2d 893, 899, 134 USPQ 355, 360 (C.C.P.A. 1962). Moreover, the Examiner is engaging in mere conjecture in stating

that "both references show the material to have sufficient thickness" and "since no specific thickness is claimed then the thickness of the material in both [the] Maged and [the] Micchia [et al] patent[s] can be considered 'sufficient' to interfere with the user's ability to look in a specific direction".

(Answer, page 7). "Anticipation of inventions set forth in product claims cannot be predicated on mere conjecture respecting the characteristics of products. . . ." W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1556, 220 USPQ 303, 314 (Fed. Cir. 1983).

Accordingly, the Examiner's anticipation rejections, regarding Micchia and Maged, cannot be sustained. Because all the § 103 rejections are based upon the Micchia patent and do not cure the above discussed infirmity, these § 103 rejections also cannot be sustained.

REMAND

We remand this application to the Examiner for action consistent with our comments below.

Claim 1 requires a sports vision-training device comprising "a piece of material having a thickness sufficient to interfere with an individual's ability to look in a specific direction at a sporting object being controlled", wherein the "piece has an

adhesive coating or layer for positioning said piece of material on a portion of an individual's face so that the said piece of material interferes with said individual's ability to look at said sporting object while attempting to control said sporting object due to said thickness."

Claim 10 requires a system for training an individual comprising "a pair of potentially disposable view restricting members; each said member being adhesively applied to one of the cheeks under an eye of said individual; and each said member having a thickness sufficient to interfere with said individual's vision if said individual attempts to look down and sufficient to encourage said individual to look in an up and forward direction towards a field of play and at least one player on said field of play."

Claim 1 appears to be satisfied by the eye patch disclosed in U.S. Patent 4,951,658 to Morgan. Morgan's eye patch is an occlusive, opaque patch that forces a patient to use his weak or lazy eye. (Column 1, lines 8-10, column 4, lines 14-16). The patch is placed over the good eye to completely block the vision of the user in that eye. (Column 1, lines 8-10, 57-60). Because the patch is "occlusive" and "opaque" and is meant to block the vision of the user, the patch necessarily must have a

thickness sufficient to perform the vision-blocking function as claimed in claim 1. Morgan also teaches using an adhesive to attach the eye patch to the user. (Column 2, lines 18-21). Moreover, because Morgan's patch is placed over an eye, it is placed on a portion of the face of an individual wearing the patch.

Claim 1 does not prohibit a complete blocking of an individual's vision using the device. Additionally, we note that Appellant's specification states that in some cases the device will "completely" restrict the individual's field of vision with regard to the sports object being controlled. (Specification, page 1, ¶ [0001]). This teaching reflects that it is reasonable and consistent with the specification to interpret claim 1 as encompassing a device which completely blocks the user's vision. In re Hyatt, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). Claim 1 appears to be anticipated by Morgan.

U.S. Patent 6,320,094 to Arnold (cited herein by the Board) teaches an eye patch that appears to anticipate Appellant's claims 1 and 10. (Column 1, lines 7-10). Arnold teaches applying her disposable eye patch to the user's face with an

adhesive layer. (Column 1, lines 7-10, Column 3, lines 34-39). As explained below, Arnold's patch has a sufficient "thickness" to satisfy the claimed vision-interfering functions of independent claims 1 and 10.³

Arnold teaches that her eye patch has first and second sheet members (11 and 12, respectively) having a thickness ranging from 0.1 mm to 5 mm (.004 to .196 inches). (Column 3, lines 39-45). As shown in Arnold's figure 3, the first and second sheets are positioned atop one another with an adhesive (13a) dispersed between them. Arnold also teaches that the first and second sheet members preferably have the same thickness. (Column 2, lines 18-19). Summing the thicknesses gives an eye patch thickness range of 0.2 to 10 mm (.008 to .292 inches). Actually, as shown in figure 3, Arnold's patch thickness will be thicker than this summed range, because of the additional thickness included by the adhesive layer 13a. Appellant indicates in his specification that the "thickness sufficient" to perform the various claimed vision-interference functions is "one quarter inch or more". (Specification, page 4). From the foregoing, Arnold teaches a patch having the same

³ With respect to claim 1, Arnold's patch placed over the eye of a user would interfere with the user's "ability to look at said sporting object while attempting to control said sporting object due to said thickness" for the reasons explained earlier.

thickness as Appellant's device (i.e. one quarter inch or greater).

Because the patch thickness disclosed by Arnold may be the same as disclosed by Appellant, it is reasonable to consider Arnold's eye patch as inherently capable of performing Appellant's vision-interference functions recited in claims 1 and 10.

While claim 1 refers to positioning the device on an individual's face generally, claim 10 recites that the vision-training device is placed specifically on the cheeks under the eyes of the individual. However, the recitation in claim 10 that the device is placed on the cheeks is considered to be an intended use of the device. With device claims, we are concerned with the structure and functional capability of the device, not how the device is used. See, In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) and Ex parte Masham, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987). Arnold's patch reasonably appears to be capable of being applied, via its adhesive, on a cheek under an eye of the user. The patch, so positioned, would inherently interfere with the user's vision as claimed since the patch has the same thickness and would be at the same location as Appellant's claimed device.

Viewed from this perspective, independent claims 1 and 10 seem to be anticipated by Arnold under the principles of inherency.

Additionally, the Examiner should consider the applicability of Morgan and Arnold to the dependent claims. For example, it appears that Morgan renders claims 3-5 and 9 anticipated. Morgan teaches constructing his patch using open-cell foam (claim 3) with a hydrocolloidal adhesive backing material (claim 5). (Column 2, lines 29-40). The adhesive and open-cell foam wick moisture away from the user and through the foam material for evaporation from the surface of the patch (claim 4). (Column 2, lines 29-40, Column 4, lines 33-43). Additionally, claim 9 appears to be anticipated by Morgan because Morgan's eye patch, as with any object, is inherently capable of being thrown away (i.e. "disposable").

Arnold appears to anticipate dependent claims 2, 9 and 15. Regarding claims 2 and 15, Arnold's patch, as explained above, has the same thickness as Appellant's device. While the positioning of the patch is considered to be an intended use, nevertheless, Arnold's patch is capable of being positioned on the face of a user such that the maximum disclosed thickness reasonably appears to be inherently capable of directing a user's vision up and toward a field of play and players thereon

(claim 2), or restricting the user's peripheral vision (claim 15). Also, Arnold teaches that her patch is disposable (claim 9). (Column 1, line 7).

Both Arnold and Morgan appear to anticipate Appellant's claims 7 and 8. With regard to claims 7 and 8, we bring to the Examiner's and Appellant's attention relevant case law regarding the rejection of claims related to logos, printed matter and designs on products. Generally, where the only difference between a prior art product and a claimed product is printed matter that is not functionally related to the substrate, the content of the printed matter will not distinguish the claimed product from the prior art. In re Ngai, 367 F.3d 1336, 1339, 70 USPQ2d 1862, 1864 (Fed. Cir. 2004). See In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); In re Miller, 418 F.2d 1392, 1396, 164 USPQ 46, 49 (C.C.P.A. 1969); MPEP § 2112.01 (Rev. 3, August 2005). Additionally, matters directed to design or ornamentation only, having no mechanical function whatever with respect to the claimed invention, cannot be relied on as a basis for patentability. In re Seid, 161 F.2d 229, 231, 73 USPQ 431, 433 (C.C.P.A. 1947). Therefore, in order for the "logo" and "written indicia" recited in Appellant's claims 7 and 8 to distinguish the product from

the prior art, there must be a functional relationship between the "logo" or "written indicia" and the substrate of the sports vision-training device. Mere ornamentation of the product will not impart patentability to an otherwise old product.

Applying this legal principle to claims 7 and 8, it appears that the "logo" and "written indicia" limitations are mere ornamentation and are not functionally related to the substrate. Appellant has disclosed nothing in his specification to indicate that the "logo" or "written indicia" serves any function other than ornamentation. As such, the "logo" and "written indicia" may not be relied upon for patentability. Since all the structural elements of claim 1, from which claims 7 and 8 depend, seem to be satisfied by both Morgan and Arnold, claims 7 and 8 appear to be anticipated by both Morgan and Arnold.

Claims 3-5, 11-13, 16 and 17 appear to be unpatentable under 35 U.S.C. § 103(a) over Arnold in view of Morgan.⁴ Claims 3, 11 and 16 all require that the device be constructed of an open-cell foam material. Arnold teaches that her patch is made of a "biocompatible foamed plastic material", but is silent as

⁴ As a matter of clarification, we point out that principles of inherency and obviousness are not necessarily incompatible. See, In re Napier, 55 F.3d 610, 613, 34 USPQ2d 1782, 1784 (Fed. Cir. 1995) and In re Skoner, 517 F.2d 947, 950, 186 USPQ 80, 82-83 (C.C.P.A. 1975).

to the foam being open-cell. (Column 2, line 15). Morgan teaches that making an eye patch out of open-cell foam material permits moisture from perspiration and wound exudate to evaporate through sides of the foam material. (Column 2, lines 36-39). Moreover, Morgan teaches that the open cell foam material increases comfort of the user and does not cause trauma to skin (i.e. skin rash). (Column 5, lines 24 and 25, column 3, lines 15, 16 and 21). Seemingly, it would have been *prima facie* obvious at the time the invention was made, to a person of ordinary skill in the art, to have combined Morgan's open-cell foam material with Arnold's biocompatible foam eye patch in view of Morgan's express teachings as to the enhanced comfort and breathability of a patch made of open-cell foam.

Claims 4, 5, 13 and 17 are all directed to using an adhesive that absorbs moisture and transfers it from the individual's skin to the device so as to evaporate the moisture. Claim 4 uses means-plus-function language ("means for absorbing moisture and transferring said moisture") that properly invokes 35 U.S.C. § 112, 6th Paragraph. The means-plus-function language satisfies the three-prong analysis set forth in MPEP § 2181: the claim language uses "means for", the "means for" language is modified by functional language ("for absorbing moisture and

transferring said moisture"), and the "means for" language is not modified by sufficient structure (or acts) for achieving the specified function. Because § 112, 6th Paragraph is properly invoked, we look to Appellant's specification to determine what structures and equivalents thereof correspond to the "means for absorbing and transferring said moisture" language. The only disclosed corresponding structure is a hydrocolloidal material. (Specification, ¶ [0021], [0024]). As such claim 4 is construed to require a hydrocolloidal material or an equivalent thereof.

Like claim 4, claims 5, 13 and 17 require a hydrocolloid as the moisture absorbing material. Arnold teaches using an adhesive to attach her patch to the user. (Column 3, lines 34-39). Appellant concedes that Morgan teaches using a hydrocolloidal adhesive material. (Brief, page 15). Morgan's hydrocolloidal adhesive wicks moisture from the user's skin through the adhesive and to the open cell foam patch for evaporation therefrom. (Column 2, lines 29-39). Moreover, Morgan teaches that using such a hydrocolloidal adhesive prevents the adhesive from being weakened by sweat or other moisture and, thereby, increases the comfort of the user. (Column 4, lines 32-38, column 5, lines 24 and 25). Seemingly, it would have been *prima facie* obvious at the time the invention

was made, to a person of ordinary skill in the art, to have used Morgan's hydrocolloidal adhesive material as the adhesive for Arnold's adhesively attached eye patch in order to increase the comfort of the user and permit the patch to adhere better to the individual's skin as taught by Morgan.

We note that the adhesive claimed in claim 12 does not require the ability to transfer moisture. As such, Arnold, alone, would teach the feature of claim 12 because Arnold teaches using an adhesive to attach the eye patch to the face of the individual. (Column 3, lines 34-39). Because of the dependency of claim 12 on 11, claim 12 would be considered for rejection under § 103 over Arnold in view of Morgan. However, since claim 12 is taught by the primary reference Arnold alone, no additional showing of motivation to combine Morgan's teachings with Arnold would be required.

Therefore, in response to this remand, the Examiner must determine, and make of record the results of this determination, the following: (1) the propriety of rejecting at least claims 1, 3-5, 7, 8 and 9 under 35 U.S.C. § 102(b) as being unpatentable over Morgan, (2) the propriety of rejecting at least claims 1, 2, 7, 8, 9, 10 and 15 under 35 U.S.C. § 102(b) as being unpatentable over Arnold, and (3) the propriety of rejecting at

least claims 3-5, 11-13 and 16-17 under 35 U.S.C. § 103(a) as being unpatentable over Arnold in view of Morgan.

This remand to the Examiner pursuant to 37 CFR § 41.50(a)(1) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)) is not made for further consideration of a rejection. Accordingly, 37 CFR § 41.50(a)(2) does not apply.

SUMMARY

In view of the foregoing, the decision of the Examiner is reversed and the application is remanded to the Examiner for further consideration of the issues mentioned in this decision.

REVERSED & REMANDED


BRADLEY R. GARRIS)
Administrative Patent Judge)
)

THOMAS A. WALTZ)
Administrative Patent Judge)
)

CATHERINE TIMM)
Administrative Patent Judge)

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BRG/mpc/tf

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